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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,729	10/11/2001	Hideki Kinugawa	214782US2X	6059
22850	7590	09/11/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	
			NOTIFICATION DATE	DELIVERY MODE
			09/11/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/973,729

Applicant(s)

KINUGAWA ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 5 and 7 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/21/07 has been entered.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1,2,4,6,8-11, are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for calculating points when the operating time (used time or load ratio) is less than the standard time (standard used time or standard load ratio), the specification does not reasonably provide enablement for calculating points regardless of whether or not the operating time (used time or load ratio) is less than standard time (standard used time or standard load ratio), which is in the scope of the independent claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. In the event that the operating time is more than the standard time, how are the points calculated? This is not clear because the only equation disclosed in the specification relates to the situation where the operating

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time is less than the standard time. One of skill in the art would not know how to go about calculating points when the operating time is more than the standard time, which is within the scope of the claims. Because one of skill in the art would have no idea how to go about calculating the points in the situation where the operating time (used time or load ratio) is more than the standard time (standard used time or standard load ratio), the examiner concludes that undue experimentation would be required. The added language to the claims of "related to a reduced consumption of the useful life of the construction machine" is not seen as overcoming this issue. This language does not appear to require what has been argued in the opinion of the examiner. Previous claim 3, which had depended to claim 1, recited "only in a case where the actual operating time...is less than the standard operating time". This is evidence of the fact that claim 1 has a scope that allows for points to be calculated when the operating time is more than the standard time.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 8,10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hideki (EP 0989525A2) in view of the article "Budget Aims for Hole in One With Innovative New Frequent Renter Program Linked to Callaway Golf Company".

For claims 8,10, Hideki discloses a system and method for the renting of construction machines with special specifications. The individual construction machines have the ability to store information relating to the use of the construction machine (operating time, fuel consumption [claimed as load ratio], etc.). See page 4, line 57 to page 5, line 6. The information control means is considered to be 20, which is a management apparatus that receives the operating information from the construction machines. Not disclosed is that a point number is calculated based on an evaluation standard. Also not claimed is that the point number is adjusted according to a stock state of available construction machines for rent. The examiner interprets this language to be reciting a point number as is used in customer loyalty programs. The Budget article discloses that the Budget vehicle rental company started a customer awards program that awards members with one point for each dollar spent. This is done so that the customer is enticed to do business with Budget and is more or less a marketing tool.

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The amount of the rental bill is dependent on the usage of the vehicle, such as how many days it was rented, or dependent on an assessed fuel charge based on the fuel tank not filled by the customer prior to returning it. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the construction machine rental system and method of Hideki with a customer awards program that awards customers points based on the amount of business they do with the construction machine rental company (which is inherently based on operating information as claimed) and to present the total number of points to the renters so that they know how many they have earned. The claimed "evaluation standard" is the standard that 1 point is awarded for every dollar spent, where the dollars spent are inherently dependent on the operating information as claimed. That is an evaluation standard to controls how the points are awarded. The amount of money that one spends on a rental is converted to points. The charge one pays for the rental is based on the use of the rental, such as how long it was rented, etc.. This satisfies the use of operating information with regards to the evaluation standard. With respect to the adjusting of the point number based on a stock state of available construction machines, the examiner views this limitation as adjusting the point numbers based on supply and demand for construction machines. The law of supply and demand in economics is very well known by one of ordinary skill in the art. The examiner sees the limitation of the adjusting of the point number calculated by the evaluation standard to be related to the supply and demand for the machines. When available supply is high and the rental owner wants to rent idle construction machines, one of ordinary skill in

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the art would recognize that you need to make the rental more attractive to the customers to get them to rent with you (i.e. a more generous points calculation per dollar spent). It would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the point number based on the supply of available construction machines, such as by offering more points for rentals when the supply is higher and less points for rentals when demand is lower.

Allowable Subject Matter

6. Claims 3,5,7, are allowed.

7. Applicant's arguments filed 6/21/07 have been fully considered but they are not persuasive.

With respect to the 112,1st rejection and the traversal, it is not persuasive. The examiner believes that the scope of the claim allows for the points to be calculated when the operating time or load ratio is more than a standard value. If this limitation was already present in claim 1, then what about the fact that claim 3 (which previously depended to claim 1) specifically recited that the operating time was less than the standard time to "further limit" what has been claimed in claim 1? This seems to be evidence that claim 1 has a scope that includes the calculation of points when the

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operating time or load ratio is more than a standard value. The rejection is being maintained.

With respect to the prior art traversal for claims 8 and 10, it is not persuasive. The examiner has addressed this in the rejection of record. The key point is that a rental is based on usage information, and if the points are awarded based on the number of dollars spent, this then means that the points are determined in part by using the operating information. The operating information can be the number of days that the machine was rented. This variable is used to determine the cost for the rental. Then the points are calculated based on the rental charge. The points are determined by using the operating information as claimed. The examiner notes applicant's position that has been argued, but the reasoning set forth by the examiner is slightly different that previously set forth. In view of this the argument is not found to be persuasive because the prior art rejection does include the calculation of points based on operating information as claimed, as has been explained by the examiner. As far as the adjusting of the point number based on a stock state, if a business owner decides to offer more points than they did before for a given dollar amount spent to try to rent out idle assets, this does result in the point number being adjusted based on a stock state. The changing from X points for each Y dollars spent, to X+Z points for each Y dollars spent. This satisfies what is claimed with respect to this limitation. The statement on page 10 of "but would not suggest awarding more points on the basis of an evaluation standard using operating information of the vehicle" does not seem to be supported by what is claimed. The point number is calculated by the evaluation standard. Then it is claimed

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that the point number (calculated by the evaluation standard) is adjusted according to a stock state of vehicles. It is not claimed that the point number is adjusted by using an evaluation standard using operating information, it is claimed that the point number is adjusted based on a stock state. The evaluation standard is not used at all in the adjusting of the point number. Applicant's argument is not commensurate with the scope of the claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER